

## REMARKS

### **I. Status of Application**

A Final Office Action was mailed January 25, 2008. However, the Examiner called Applicant's representative, Joseph Herndon, on February 13, 2008 to inform the Applicant that the indication of a Final Office Action was in error, and that the communication was a Non-Final Office Action.

Applicant requested an Interview to discuss the rejection of all pending claims 1-3, 5 and 7-15 over U.S. Patent No. 7,158,625 (Casaccia) as stated within the Office Action Mailed January 25, 2008. However, the Examiner then informed Applicant that the Office Action mailed January 25, 2008 had been withdrawn and that a new non-final Office Action had been mailed.

The Office mailed a non-final Office Action on March 12, 2008, which is stated to be a supplemental action to the Final Office Action dated January 25, 2008. The Office Action mailed March 12, 2008 further states that Applicant's arguments filed in the response mailed December 17, 2007 had been acknowledged and considered but moot in view of the new grounds of rejection. Applicant responds to the present non-final Office Action mailed March 12, 2008 with the understanding that the Final Office Action mailed January 25, 2008 has been withdrawn.

In the Office Action mailed March 12, 2008, the Examiner rejected claims 1, 9 and 12 under 35 U.S.C. § 112, and rejected all pending claims 1-3, 5 and 7-15 under 35 U.S.C. § 103(a) as being unpatentable over Bond (U.S. Pub. 2005/0047389) in view of Somekh (U.S. Pub. 2003/0123466).

## **II. Response to Rejection of Claims under 35 U.S.C. § 112**

The Examiner rejected claims 1, 9 and 12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Regarding claims 1, 9, and 12, the Examiner stated that while “completion of the setup can only be carried out upon receiving the SIP 200 OK message, it seems that the claim languages state otherwise. Again, the completion of the setup can be only carried out if and only if the SIP 200 OK message has been received from the terminating station, not upon receiving the cancellation message. In a way, whether receiving a cancellation message or not from the originating station, the completion of setting up conference leg is carried out regardless. The claim languages, therefore, are not clear.” (Office Action, p. 2).

Applicant disagrees with the Examiner. It is true that the conference leg between the conference server and the terminating station will be completed upon receiving the agreement message (e.g., SIP 200 OK) from the terminating station and following by sending an acknowledgement message (e.g., SIP ACK) from the server to the terminating station. However, the claim language is clear in that the cancellation message triggers “sending a teardown message from the conference server to the terminating station to tear down the conference leg between the conference server and the terminating station.” However, to tear down the conference leg, the conference leg must first be setup. Thus, as recited in claim 1, in response to the cancellation message, two steps occur: “(i) completing setup of the conference leg between the conference server and the terminating station and (ii) then sending a teardown message from the conference server to the terminating station to tear down the conference leg between the conference server and the terminating station.”

This differs from the conventional technique described in the patent application in which the cancellation message would be ignored if received prior to completing setup of the conference leg. (See Background of Specification, pages 3-4).

Applicant asserts that the claim language is clear and recites concise message flows between the originating station, the conference server, and the terminating station. Applicant requests withdraw of the present § 112 claim rejections.

### **III. Response to Rejection of Claims under 35 U.S.C. § 103(a)**

The Examiner rejected all pending claims 1-3, 5 and 7-15 under 35 U.S.C. § 103(a) as being unpatentable over Bond (U.S. Pub. 2005/0047389) in view of Somekh (U.S. Pub. 2003/0123466).

Enclosed is a Declaration Pursuant to 37 C.F.R. §1.131 along with supporting exhibits. The Declaration operates to swear behind Bond. More specifically, the Declaration states that the claimed invention was conceived at least prior to September 3, 2003 (i.e., the earliest possible 102(e) date of Bond).

Subsequently, the inventors were reasonably diligent in reducing the invention to practice from prior to September 3, 2003 to the filing of the patent application on October 9, 2003. The inventors were in communication with the Attorneys preparing the application to provide explanatory details of the invention, and comments on drafts of the application during this time. The dates on the Exhibits to the enclosed Declaration have been redacted; however, the dates demonstrate that the inventors and Attorneys worked with reasonable diligence on the application during the continuous period from prior to September 3, 2003 to October 9, 2003.

In addition, the invention was conceived and reduced to practice in the United States. Accordingly, because the present invention was invented before the earliest 102(c) date of Bond

and subsequently reduced to practice in a diligent manner, the Bond reference cannot be applied as prior art against the present application. Thus, the rejection of the pending claims based upon the Bond reference should be withdrawn.

#### **IV. Conclusion**

Applicant submits that all of the pending claim rejections have been overcome. Applicant therefore respectfully requests withdraw of the pending claim rejections and that a Notice of Allowance be given on the pending claims. The Examiner is invited to call the undersigned at (312) 913-3331 with any questions or comments.

Respectfully submitted,

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